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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Plow)	Art Unit: 2132
)	
Serial No.: 09/922,196)	Examiner: Ungar
)	
Filed: August 2, 2001)	SVL920000036US1
)	
For: SYSTEM, METHOD, AND COMPUTER)	July 20, 2005
PROGRAM PRODUCT FOR AUTOMATICALLY)	750 B STREET, Suite 3120
INPUTTING USER DATA INTO INTERNET)	San Diego, CA 92101
BASED ELECTRONIC FORMS)	

APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

Table of Contents

<u>Section</u>	<u>Title</u>	<u>Page</u>
(1)	Real Party in Interest.....	2
(2)	Related Appeals/Interferences.....	2
(3)	Status of Claims.....	2
(4)	Status of Amendments.....	2
(5)	Concise Explanation of Subject Matter in Each Independent Claim.	2
(6)	Grounds of Rejection to be Reviewed.....	4
(7)	Argument.....	5
App.A Appealed Claims		
App.B Evidence Appendix		
App.C Related Proceedings Appendix		

1176-4.APP

07/25/2005 HUUONG 00000022 090460 09922196

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CASE NO.: SVL920000036US1
Serial No.: 09/922,196
July 20, 2005
Page 2

PATENT
Filed: August 2, 2001

(1) Real Party in Interest

The real party in interest is IBM Corp.

(2) Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims

Claims 1-16 and 24-27 are pending and finally rejected. All rejections are appealed. Claims 17-23 have been canceled.

(4) Status of Amendments

An amendment canceling Claims 17-23 has been submitted and presumably will be entered for appeal.

(5) Concise Explanation of Subject Matter in Each Independent Claim, with Page and Figure Nos.

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 recites a method for automatically inputting user information to an electronic form provided to a user computer from a server that includes receiving the electronic form at the user computer, with the electronic form requiring user information to be input thereto, page 6, lines 10-12, figure 2. User

1176-4.APP

CASE NO.: SVL920000036US1
Serial No.: 09/922,196
July 20, 2005
Page 3

PATENT
Filed: August 2, 2001

information is retrieved from memory, id., lines 14-16, and the method automatically inputs the user information to the electronic form, id., lines 17-19. The user information stored in the user computer is updated in response to the user manually inputting data to the form, page 7, lines 2-5, figure 2; page 8, lines 12-14. The method also includes providing a menu of user names with each user name corresponding to a respective autofill profile, reference numeral 47, figure 3, page 9, lines 9-11, and allowing a user to select his or her name from the menu so that the autofill profile corresponding to the selected name is used to provide information to the electronic form, id.

The reference citations above are incorporated herein. Claim 9 sets forth a system for automatically inputting user information to an Internet based electronic form. The system includes a server (22, figure 1, page 5, line 1), at least one database connected to the server and storing plural electronic forms, 24, figure 1, page 5, line 2, and at least one user computer connected to the server via an Internet connection, 12, 18, figure 1, page 4, lines 15-20. The server transmits at least one electronic form to the user computer, supra, and the user computer includes a program for automatically inputting user information stored on the user computer to the electronic form and automatically selectively updating user information stored on the user computer, supra. The computer also provides a menu of user names with each user name corresponding to a respective autofill profile, with the computer allowing a user to select a name from the menu so that the autofill profile corresponding to the selected name is used to provide information to the electronic form, supra.

The reference citations above are incorporated herein. Claim 24 sets forth a method for automatically inputting user information to an electronic form provided to a user computer from a server which includes receiving the electronic form at the user computer, automatically filling the form using an autofill profile,

1176-4_APP

CASE NO.: SVL920000036US1

Serial No.: 09/922,196

July 20, 2005

Page 4

PATENT

Filed: August 2, 2001

and receiving user input to the form, supra. Based on the user input, the autofill profile is updated, supra. The method further includes providing a menu of user names with each user name corresponding to a respective autofill profile, and allowing a user to select a name from the menu so that the autofill profile corresponding to the selected name is used to provide information to the electronic form, supra.

The reference citations above are incorporated herein. Claim 25 recites a method for completing electronic forms received at a computer that includes receiving a first electronic form at the computer, the first electronic form being transmitted by a first server, inputting user information into at least one input field provided by the first electronic form, and returning the first electronic form to the first server with the user information, supra. The method also includes receiving a second electronic form at the computer, with the second electronic form being transmitted by a second server and with the user information automatically appearing in at least one input field of the second electronic form, supra. The method still further includes providing a menu of user names with each user name corresponding to a respective autofill profile, and allowing a user to select a name from the menu so that the autofill profile corresponding to the selected name is used to provide information to the electronic form, supra.

(6) Grounds of Rejection to be Reviewed on Appeal

(a) Claims 1-4, 9-12, 14, 17-19, 21, and 24-26 have been rejected under 35 U.S.C. §102 as being anticipated by Pennell et al., USPP 2002/0013788.

(b) Claims 5-8, 13, 15, 16, 20, 22, 23, and 27 have been rejected under 35 U.S.C. §103 as being unpatentable over Pennell et al. in view of Kikinis, USPN 5,794,259.

11764.APP

CASE NO.: SVL920000036US1
Serial No.: 09/922,196
July 20, 2005
Page 5

PATENT
Filed: August 2, 2001

(7) Argument

As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner's answer should be "rare", and should be levied only in response to such things as newly presented arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, *id.*, page 49979.

(a) An important difference exists between Pennell et al. and independent Claims 1, 9, 24, and 25. In the claims, "the form" is the data structure received from the server. User information that is stored in memory is automatically input to this form, i.e., the form received from the server. This user information is updated in response to the user manually inputting data to the form, i.e., the form received from the server.

In contrast, the relied-upon window 401 that is part of the user computer of Pennell et al. is what is used for autofilling the underlying form 100 from the server, paragraph 27. The window 401 itself may be automatically filled or manually filled by the user, *id.*, but regardless, in terms of Claim 1, the window 401 is the thing that is used to automatically fill in the form from the server. It is not the server form 100 itself. The window 401 is not received from the server as otherwise required by the claims, but rather is a pop-up window that is generated and displayed by the browser of the user computer, evidently based on a "script" of undisclosed origin, paragraph 27. The fact that the pop-up window 401 is not received from the server is further shown by paragraph 29, which teaches that a user name from the user computer, not from the server, can be displayed in the pop-up window 401.

1176.4.APP

CASE NO.: SVL920000036US1
Serial No.: 09/922,196
July 20, 2005
Page 6

PATENT
Filed: August 2, 2001

With this in mind, while it is true as the examiner observes that paragraph 32 of Pennell et al. teaches updating user information, note that it is the information in the window 401 that is stored in the local database 304 with time stamp information, so that the most current user information can be kept. Nowhere in the sections of Pennell et al. that have been relied upon in the rejections is manual user data input to the server form 100 itself discussed, much less that direct user manual input to the server form 100, as opposed to the autofill window 401, is used for updating user information. Accordingly, should a user find it necessary to enter information directly into the server form 100 in Pennell et al., unlike Claim 1 the entered data would not be used to update the user information.

The above explanation has been met with the contention that the rejections are sound because they are based on a "reasonably broad" claim construction. Appellant is mindful that examiners may give claims their broadest reasonable interpretation under MPEP §2111, but that does not mean that explicit recitations may be erased under the guise of broad claim interpretation. No matter how broadly the present claims are interpreted, there is no way to equate what they require - particular autofill activities performed on a *form that is received from a server* - with Pennell et al., wherein the relied-upon activities are *performed on a pop-up window that resides in the user computer database*.

(b) The obviousness rejections are based on equating the claimed PINs to Kikinis' passwords, citing a dictionary definition that interestingly does not define a "PIN" to be a "password". Because the examiner's own dictionary fails to make the relied-upon equivalence, the rejections should be reversed.

1176-4,APP

CASE NO.: SVL920000036US1
Serial No.: 09/922,196
July 20, 2005
Page 7

PATENT
Filed: August 2, 2001

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1176-4 APP

CASE NO.: SVL920000036US1

Serial No.: 09/922,196

July 20, 2005

Page 8

PATENT

Filed: August 2, 2001

APPENDIX A - APPEALED CLAIMS

1. A method for automatically inputting user information to an electronic form provided to a user computer from a server, comprising the acts of:
 - receiving the electronic form at the user computer, the electronic form requiring user information to be input thereto;
 - retrieving user information from memory;
 - automatically inputting the user information to the electronic form;
 - updating the user information stored in the user computer in response to the user manually inputting data to the form;
 - providing a menu of user names with each user name corresponding to a respective autofill profile; and
 - allowing a user to select his or her name from the menu so that the autofill profile corresponding to the selected name is used to provide information to the electronic form.
2. The method of Claim 1, further comprising the act of:
 - allowing the user to edit information required by the electronic form.
3. The method of Claim 1, further comprising the act of:
 - receiving a second electronic form, the second electronic form requiring user information to be input thereto;
 - retrieving updated user information from memory; and
 - automatically inputting the updated information to the second electronic form.
4. The method of Claim 1, further comprising the act of:
 - when the electronic form is submitted to the server, selectively creating an autofill profile at the user computer, the user information being stored in the autofill profile.
5. The method of Claim 4, further comprising the act of:
 - establishing a personal identification number (PIN).
6. The method of Claim 5, further comprising the act of:
 - encrypting the autofill profile; and
 - saving the autofill profile, further access to the information within the autofill profile being at least partially based on the PIN.
7. The method of Claim 6, further comprising the act of:
 - when another electronic form is transmitted from the server to the user computer, selectively requiring the user to enter the PIN.
8. The method of Claim 7, further comprising the act of:

1176-4.APP

CASE NO.: SVL920000036US1

Serial No.: 09/922,196

July 20, 2005

Page 9

PATENT

Filed: August 2, 2001

when a correct PIN is entered, decrypting the autofill profile; and
automatically inputting user information from the autofill profile to the electronic form

9. A system for automatically inputting user information to an Internet based electronic form, comprising:

at least one server;

at least one database connected to the server, the database storing plural electronic forms; and

at least one user computer connected to the server via an Internet connection, the server transmitting at least one electronic form to the user computer, the user computer including a program for automatically inputting user information stored on the user computer to the electronic form and automatically selectively updating user information stored on the user computer, the computer providing a menu of user names with each user name corresponding to a respective autofill profile, the computer allowing a user to select a name from the menu so that the autofill profile corresponding to the selected name is used to provide information to the electronic form.

10. The system of Claim 9, wherein the program includes:

logic means for receiving the electronic form at the user computer, the electronic form requiring user information to be input thereto;

logic means for retrieving user information from memory;

logic means for automatically inputting the user information to the electronic form;

and

logic means for updating the user information stored in the user computer in response to a user manually inputting data to the form.

11. The system of Claim 10, wherein the program further includes:

logic means for allowing the user to edit the electronic form.

12. The system of Claim 10, wherein the program further includes:

logic means for selectively creating an autofill profile at the user computer when the electronic form is submitted to the server, the user information being stored in the autofill profile.

13. The system of Claim 12, wherein the program further includes:

logic means for establishing a personal identification number (PIN).

14. The system of Claim 13, wherein the program further includes:

logic means for encrypting the autofill profile; and

logic means for saving the autofill profile.

11764.APP

CASE NO.: SVL920000036US1

Serial No.: 09/922,196

July 20, 2005

Page 10

PATENT

Filed: August 2, 2001

15. The system of Claim 14, wherein the program further includes:
logic means for selectively requiring the user to enter the PIN when another electronic form is transmitted from the server to the user computer.
16. The system of Claim 15, wherein the program further includes:
logic means for decrypting the autofill profile when a correct PIN is entered; and
logic means for automatically inputting user information from the autofill profile to the electronic form.
24. A method for automatically inputting user information to an electronic form provided to a user computer from a server, comprising the acts of:
receiving the electronic form at the user computer, the electronic form requiring user information to be input thereto;
automatically filling the form using an autofill profile;
receiving user input to the form;
based on the user input, updating the autofill profile;
providing a menu of user names with each user name corresponding to a respective autofill profile; and
allowing a user to select a name from the menu so that the autofill profile corresponding to the selected name is used to provide information to the electronic form.
25. A method for completing electronic forms received at a computer, comprising the acts of:
receiving a first electronic form at the computer, the first electronic form being transmitted by a first server;
inputting user information into at least one input field provided by the first electronic form;
returning the first electronic form to the first server with the user information; and
receiving a second electronic form at the computer, the second electronic form being transmitted by a second server, the user information automatically appearing in at least one input field of the second electronic form;
providing a menu of user names with each user name corresponding to a respective autofill profile; and
allowing a user to select a name from the menu so that the autofill profile corresponding to the selected name is used to provide information to the electronic form.
26. The method of Claim 25, further comprising the act of:
editing at least one of: the first electronic form or the second electronic form.
27. The method of Claim 25, further comprising the act of:

11764.APP

CASE NO.: SVL920000036US1

Serial No.: 09/922,196

July 20, 2005

Page 11

PATENT

Filed: August 2, 2001

establishing a personal identification number (PIN) corresponding to the user information.

1176-4.APT

CASE NO.: SVL920000036US1
Serial No.: 09/922,196
July 20, 2005
Page 12

PATENT
Filed: August 2, 2001

APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1176-4.APP

CASE NO.: SVL920000036US1
Serial No.: 09/922,196
July 20, 2005
Page 13

PATENT
Filed: August 2, 2001

APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1176-4 APP